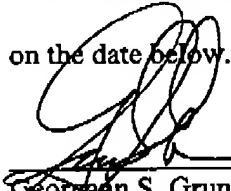RECEIVED
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PATENT
Customer No. 020991

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Robert G. Arsenault et al.	I hereby certify that this correspondence is being facsimile transmitted to (571) 273-8300 (Centralized Facsimile) and addressed to:
Serial No.: 09/534,708	
Filing Date: March 24, 2000	Mail Stop AF Commissioner for Patents P. O. Box 1450 Alexandria VA 22313-1450
For: METHOD AND APPARATUS FOR CONDITIONALLY PROCESSING, STORING, AND DISPLAYING DIGITAL CHANNEL CONTENT IN A TELEVISION RECEPTION SYSTEM	on the date below.
Group Art Unit: 2623	Georgean S. Grunebach (Typed or printed name of person signing certificate)
Examiner: TRAN, Hai V.	
Attorney Docket No.: PD-980130	Date: April 24, 2007

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.
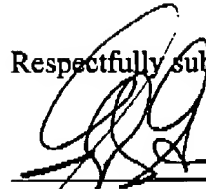
This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

I am the attorney or agent of record.

Serial No. 09/534,708

Respectfully submitted,

Georgann S. Grunebach
Reg. No. 33,179
Attorney for Applicants
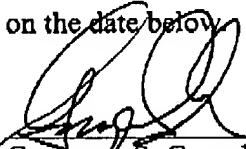
Dated: April 24, 2007

The DirecTV Group, Inc.
CA/LA1/A109
P.O. Box 956
2230 E. Imperial Highway
El Segundo, CA 90245-0956
Phone: (310) 964-4615

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REASONING ACCOMPANYING A PRE-APPEAL BRIEF REQUEST FOR REVIEW

The applicants file herewith a Notice of Appeal and respectfully request review of this case prior to filing an appeal brief. As addressed below, the rejections on the record omit essential elements required for a *prima facie* rejection. Thus, the applicants respectfully request allowance of the claims or the reopening of prosecution.

Relevant Prosecution History

A non-final Office action, dated August 10, 2006, rejected claims 28-30 and 32-47 as unpatentable over Gordon (US Pub. No. 2001/0056577) and Beyers (US 5,381,477).

In response to the non-final Office action, the applicants agreed with the examiner's assertion that Gordon does not disclose conditional logic evaluated by a receiver based on receiver characteristics. In addition, the applicants pointed out that Beyers does not cure the

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deficiency of Gordon. In particular, bitmap locking information described by Beyers is not conditional logic evaluated by a receiver based on receiver characteristics. The details of the applicants arguments are still applicable and are explained below.

A final Office action was mailed on January 24, 2007, maintaining the rejections of the non-final Office action. In response to the applicants' arguments, the final Office action provided several arguments that are based on an incorrect understanding of Beyers. Because the applicants and the examiner have arrived at diametrically opposed positions, the applicants had little choice but to file this pre-appeal brief request and a notice of appeal.

Response to the Rejections

Claim 1 recites a method comprising, *inter alia*, adding conditional logic to channel objects that include more than one channel definition, the conditional logic including one or more rules that must be evaluated by a receiver to identify a first channel definition or a second channel definition based on receiver characteristics data representing a characteristic of the receiver.

The Office action rejected claim 1 as unpatentable under 35 U.S.C. § 103 over Gordon in view of Beyers. In the final Office action, the examiner contended that Gordon describes all of the recitations of claim 1, a point that the applicants do not concede. The examiner did, however, concede that Gordon does not describe or suggest that conditional logic is evaluated by a receiver based on receiver characteristics data representing a characteristic of the receiver. (Final Office action, Page 6). The examiner seeks to cure the admitted deficiency of Gordon by citing Beyers. However, as described below, the examiner has failed to show all of the recitations of the claims as required for a *prima facie* case of obviousness.

In arguing that Beyers describes conditional logic evaluated by a receiver based on receiver characteristics data representing a characteristic of the receiver, the first non-final Office action and the final Office action cited Beyers col. 2, lines 42-65+. However, the cited portion of Beyers does not describe or suggest conditional logic evaluated by a receiver. Rather, as described below, these portions of Beyers describe the use of a host billing computer to group subscribers and send messages to the subscriber groups.

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The cited portion of Beyers states "... there remains a need in the art of subscription television services to permit the system operator to provide individualized messages ..." (Beyers col. 2, lines 43-45). In other words, Beyers is directed to messages from system operators. In the Technical Field section, Beyers states "the transmission of messages to said predetermined groups and communication with a host billing computer" are facilitated by this "invention." (Col. 1, lines 15-22). Returning to the examiner's citation, Beyers states that the described method comprises the steps of "storing criteria related to terminals of a subscription television system, ... comparing the stored terminal criteria with the criteria definition statement, and assigning an individual or group of terminals to the group." (Beyers col. 2, lines 55-62). In other words, the cited portion of Beyers clearly describes that the assigning of groups is performed at the host billing computer. There is no indication in the cited portion of Beyers that conditional logic is evaluated by a receiver based on receiver characteristics data representing a characteristic of the receiver nor does the examiner provide any justification for such an assertion in the final Office action or the first non-final Office action.

In response to the applicants arguments in the first Office action, the examiner additionally cited Beyers Col. 9, lines 9-37. In discussing the citation, the examiner stated

> Transaction Type A is of finite length and may be considered to comprise a data packets of a plurality of bytes in a particular sequence and including at least apportion of a data stream which may have a transaction code associated therewith... Message data for display on an addressable subscriber terminal may be transmitted to subscribers using these transaction. Depending on the length of the messages, the characteristic of the subscriber terminals and the scramblers and other factors, the particular length and arrangement of message data within these transactions may be varied to suit the particular configuration.

(Final Office action, Page 2-Page 3) (emphasis removed). The applicants respectfully submit that the arguments fail to show how Beyers describes conditional logic evaluated by a receiver based on receiver characteristics data representing a characteristic of the receiver. Rather, the cited portion of Beyers merely indicates that the length and arrangement of message data may be

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varied based on the particular configuration and desired parameters to be included in the message.

The examiner further argued "A transaction code or operand provides a command or instruction that the subscriber terminal (or terminals) addressed by the transaction is to follow. The depicted data is for operation according to the operation or transaction code." (Final Office action, Page 3). However, a command or an instruction is not inherently conditional logic. Rather, the use of phrase "command or instruction" by Beyers implies a singular command or singular instruction. It is not clear to the applicants, and the examiner has provided no explanation, as to how a singular instruction can be conditional logic.

It is well established that the prior art must teach or suggest each of the claim elements and must additionally provide a suggestion of, or an incentive for, the claimed combination of elements to establish a *prima facie* case of obviousness. See *In re Oetiker*, 24 USPQ. 2d 1443, 1446 (Fed. Cir. 1992); *Ex parte Clapp*, 227 USPQ. 972, 973 (Bd. Pat. App. 1985); *In re Royka*, 490 F.2d 981 (CCPA 1974) and M.P.E.P. § 2143. In this case, neither Gordon (as admitted by the examiner) nor Beyers describes or suggests that conditional logic is evaluated by a receiver based on receiver characteristics data representing a characteristic of the receiver. Thus, it is respectfully submitted that, because the prior art fails to teach or suggest each of the claim elements, no *prima facie* case of obviousness of claim 1 has been made.

Similarly, claim 36 recites a method comprising, *inter alia*, each channel object associated with one of the television channels, each channel object including at least one channel definition that identifies the channel content components including a video component or an audio component needed to construct the television channel associated with that channel object for display and responding to the tuning request by evaluating the conditions in the one or more rules of the channel object associated with the selected television channel and identifying a first channel definition or a second channel definition for that television channel based on receiver characteristics data representing a characteristic of the receiver. As previously described, because the examiner has failed to show how Gordon or Beyers describes or suggests conditional logic is evaluated by a receiver based on receiver characteristics data representing a

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characteristic of the receiver, it is respectfully submitted that no *prima facie* case of obviousness
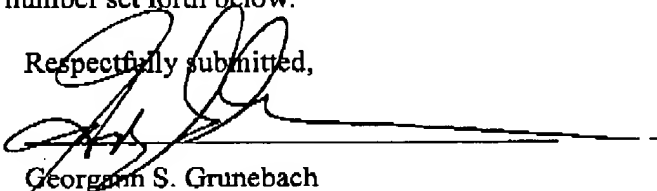of claim 36 has been made.

Similarly, claim 37 recites a system comprising, *inter alia*, each channel object associated
with one of the television channels, each channel object including at least one channel definition
that identifies the channel content components including a video component or an audio
component needed to construct the television channel associated with that channel object for
display and a controller coupled to the memory, the controller receiving a tuning request that
selects a television channel, the controller responding to the tuning request by evaluating the
conditions in the one or more rules of the channel object associated with the selected television
channel and identifying a first channel definition or a second channel definition for that
television channel based on system characteristics data representing a characteristic of the
system. As previously described, because the examiner has failed to show how Gordon or
Beyers describes or suggests conditional logic is evaluated by a receiver based on receiver
characteristics data representing a characteristic of the receiver, it is respectfully submitted that
no *prima facie* case of obviousness of claim 37 has been made.

Reconsideration of the application and allowance thereof are respectfully requested. If
there is any matter that the examiner would like to discuss, the examiner is invited to contact the
undersigned representative at the telephone number set forth below.

Dated: April 24, 2007   Respectfully submitted,

The DirecTV Group, Inc.   George H S. Grunebach
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